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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,709	08/07/2001	Martin Sielaff	2004001111-1	1241

22879 7590 10/31/2007  
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FORT COLLINS, CO 80527-2400

EXAMINER
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NGUYEN, DUSTIN

ART UNIT	PAPER NUMBER
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2154

MAIL DATE	DELIVERY MODE
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10/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/922,709

Applicant(s)

SIELAFF ET AL.

Examiner

Dustin Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 6-23 are presented for examination.

#### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. It appears claim 6 would reasonably be interpreted by one of ordinary skill in the art as software per se, failing to fall within a statutory category of invention. As such, the system of software alone is not a machine, and it is clearly not a process, manufacturer nor composition of matter [ Please see MPEP chapter 2106 ].

#### *Response to Arguments*

3. As per remarks, Applicants argued that (1) claim 6 is statutory, is functional, is not an abstract idea, and does produce a tangible and concrete result, and therefore overcomes the rejection under 35 U.S.C. 101.

4. As to point (1), it appears claim 6 would reasonably be interpreted by one of ordinary skill as a system of software per se, failing to fall within a statutory category of invention.

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Applicant's disclosure contains intrinsic evidence that a rules-based agent contains rules clauses and may be written in extensible markup language (XML) [ i.e. software ] [ paragraph 0065 ], trigger, provider and action can be simply a small piece of code [ i.e. software ] [ paragraphs 0066-0068 ]. Claim 6 claims system of rules-based agent, targeted advertising trigger, data provider and action [ i.e. software ]. As such, the system of software alone is not a machine, and it is clearly not a process, manufacture nor composition of matter.

5. As per remarks, Applicant's argued that (2) Greer is not teach or suggest the feature of a rules-based agent operating on said user computer.

6. As to point (2), Greer specifically states transmitting an agent and ad banner from a content provider to a target computer [ Abstract ] and using information collected by the agent running on the target computer to generating new advertising banners [ i.e. a rules-based agent operating on said user computer ] [ 308 and 312, Figure 3; and paragraphs 0001 and 0013 ].

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 6-15, 18, 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greer et al. [ US Patent Application No 2001/0011226 ], in view of Ehring et al. [ US Patent Application No 2005/0097008 ].

9. As per claim 6, Greer discloses the invention substantially as claimed including a rules evaluation system for a user computer [ i.e. a set of databases containing advertising banners and other content for dissemination and transmission to target computers, wherein the content is controlled by rules in a rule book ] [ Figure 1; and paragraph 0012 ], said rules evaluation system comprising:

a rules-based agent operating on said user computer [ i.e. the agent runs on the target computer CPU ] [ 312, Figure 3; and paragraphs 0017 and 0019 ] and having a plurality of rule clauses for evaluating data [ i.e. rule pages ] [ paragraph 0018 ];

at least one targeted advertising trigger having functionality to notify the rules-based agent to begin evaluating [ i.e. triggering program to determine if the data is important ] [ 316, Figure 3; and paragraphs 0020 and 0021 ];

a plurality of data providers to provide data for evaluation [ i.e. several content providers ] [ Figure 1; paragraphs 0011, 0012 and 0020 ]; and

at least one action for providing information upon the evaluated data [ i.e. transmit new ad banner and/or content to user ] [ 336, Figure 3; and paragraphs 0002 and 0025 ], and wherein at least one of said at least one action comprises displaying a prompt associated with said target advertising triggers [ i.e. display ad banner ] [ Abstract; and paragraphs 0002, 0023 and 0025 ].

Greer does not specifically disclose

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wherein the rules clauses comprises one or more required rules clauses and one or more optional rules clauses; and

wherein an action is performed provided all of the required rules clauses and at least one of the optional rules clauses are satisfied; and wherein said prompt leads to a sale.

Ehring discloses

wherein the rules clauses comprises one or more required rules clauses and one or more optional rules clauses [ i.e. AND/OR boolean ] [ paragraph 0013 ]; and

wherein an action is performed provided all of the required rules clauses and at least one of the optional rules clauses are satisfied [ i.e. inclusive and exclusive relationship ] [ paragraph 0113 ]; and wherein said prompt leads to a sale [ i.e. make a sale ] [ paragraphs 0040 and 0144 ].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Greer and Ehring because the teaching of Ehring would enable application/web site authors to formulate rules that not only determine dynamically which content is rendered to which users, but which further the author's goals by adapting the selection of content to each user's unique scenario [ Ehring, paragraphs 0001 0012 ].

10. As per claim 7, Greer discloses wherein the trigger is based upon user activity [ i.e. user spends more than 10 minutes at basketball website or clicks on many icons ] [ paragraph 0023 ].

11. As per claim 8, Greer discloses wherein the trigger is based upon time [ i.e. the amount of time spend at a website ] [ paragraph 0013 ].

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12. As per claim 9, Greer discloses wherein the trigger is based upon computer online activity [ i.e. web sites visited ] [ paragraph 0013 ].

13. As per claim 10, Greer discloses wherein the trigger is based upon hardware present in the computer [ i.e. hardware profile ] [ paragraphs 0013 and 0014 ].

14. As per claim 11, Greer discloses wherein the trigger is based upon software present in the computer [ i.e. software profile ] [ paragraphs 0013 and 0014 ].

15. As per claim 12, Greer discloses wherein rule clauses can be added dynamically [ i.e. modify ] [ paragraph 0021 ].

16. As per claim 13, Greer discloses wherein triggers can be added dynamically [ i.e. customize ] [ paragraphs 0023 and 0025 ].

17. As per claim 14, Greer discloses wherein data providers can be added dynamically [ paragraphs 0011 and 0018 ].

18. As per claim 15, Greer discloses wherein action can be added dynamically [ i.e. rule condition actions pair ] [ paragraph 0022 ].

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19. As per claim 18, Greer discloses wherein the data provider detects an amount of memory installed on the user's computer [ i.e. hardware profile ] [ paragraphs 0014 and 0017 ].

20. As per claim 20, Greer discloses wherein the action is a pop-up box displayed to the user [ i.e. ad banner ] [ Abstract; and paragraphs 0006 and 0019 ].

21. As per claim 23, Ehring discloses wherein the action is a video displayed on the user's computer [ paragraphs 0014 and 0172 ].

22. Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greer et al. [ US Patent Application No 2001/0011226 ], in view of Ehring et al. [ US Patent Application No 2005/0097008 ], and further in view of Binder [ US Patent No 6,513,052 ].

23. As per claim 17, Greer, Ehring do not specifically disclose wherein the data provider detects a speed of the user's computer hard drive. Binder discloses wherein the data provider detects a speed of the user's computer hard drive [ Abstract; col 1, lines 59-64; col 3, lines 21-26; and col 4, lines 24-30 ]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Greer, Ehring and Binder because Binder's teaching of current hardware configuration would enable to select and present advertisement that has a high correlation to the user's needs, behavior, and preferences, thereby increasing the probability of generating revenue from the advertising [ Binder, col 1, lines 49-54 ].



24. As per claim 19, Greer and Ehring do not specifically disclose wherein the data provider detects downloaded software. Binder discloses wherein the data provider detects downloaded software [ col 4, lines 30-39; and col 5, lines 61-col 6, lines 11 ]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Greer, Ehring and Binder because Binder's teaching of current software configuration would enable to select and present advertisement that has a high correlation to the user's needs, behavior, and preferences, thereby increasing the probability of generating revenue from the advertising [ Binder, col 1, lines 49-54 ].

25. Claims 16, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greer et al. [ US Patent Application No 2001/0011226 ], in view of Ehring et al. [ US Patent Application No 2005/0097008 ], and further in view of Istvan [ US Patent Application No 2002/0042747 ].

26. As per claim 16, Greer and Ehring do not specifically disclose wherein the data provider detects a level of ink in the user's printer. Istvan discloses wherein the data provider detects a level of ink in the user's printer [ i.e. generate signal when low ink level ] [ Figures 12 and 13; Abstract; and paragraphs 0073, 0083, 0089 and 0092 ]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Greer, Ehring and

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Istvan because the teaching of Istvan would provide maintenance support for the system before the system corrupted.

27. As per claim 21, Istvan discloses wherein the action is an e-mail sent to the user [ i.e. e-mail notification ] [ paragraphs 0008, 0009, 0076 and 0080 ].

28. As per claim 22, Istvan discloses wherein the action is a link to a related website presented to the user [ i.e. URL ] [ paragraphs 0068 and 0069 ].

29. Applicant's arguments with respect to claims 6-23 have been considered but are moot in view of the new ground(s) of rejection.

30. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on Monday - Friday 8:30 a.m. - 5:30 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3970.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'Nathan Flynn', is located in the lower right quadrant of the page.